

REMARKS

Claims 1 – 28 have been examined and stand rejected under 35 U.S.C. §103(a). Claims 26 – 28 have been canceled without prejudice.

The pending claims are directed to a method and system for providing financial services over a public network. As explained in the specification, this is performed in an embodiment by using a portable computer-readable storage medium as a substitute for a more traditional debit card (Application, p. 4, ll. 24 – 26). As a counterpart to a traditional debit card, this computer-readable storage medium includes information similar to that contained on the magnetic stripe of a debit card. Notably, however, this information is encrypted on the computer-readable storage medium, while a traditional debit card does not include any encrypted information. The computer-readable storage medium may be used for electronic commercial transactions in a manner similar to how a debit card is used: when a customer wishes to purchase a product from a Web site, a microprocessor in the customer's personal computer retrieves the encrypted information from the computer-readable storage medium and transmits it to a server, which then forwards a request to debit a specified amount with the encrypted information (*id.*, p. 5, ll. 5 – 17). These features are reflected in independent Claims 1 and 17 with language that requires *encrypted information retrieved from a computer-readable storage medium to be used in determining access to a customer's financial account*.

This is neither taught nor suggested in the references cited in the rejections of the independent claims. In particular, those rejections cite a combination of U.S. Pat. No. 5,903,881 ("Schrader") and U.S. Pat. No. 5,457,746 ("Dolphin").

Schrader is cited for its disclosure of an online banking system (Second Office Action, p. 4) and it is noted that the computer application may be delivered to the user on a CD ROM (*id.*, p. 5). The use of a CD ROM in this context, however, is nothing more than as a delivery means for the software product, with Schrader noting that other delivery means could also be used (Schrader, Col. 12, ll. 62 – 67). Notably, the CD ROM is *not* needed to perform any of the banking applications described in Schrader after the computer program has been installed on a user's computer. In this respect, it is no different than most commercially available software. The Office Action also notes that Schrader discloses an encryption module for exchanging transaction information (Second Office Action, p. 2). This is not believed to be relevant to the claims because they never recite performing an encryption as disclosed by Schrader; they instead recite the very different function of retrieving *previously encrypted* information from the computer-readable storage medium. In addition, Schrader only discloses encrypting transaction information; it specifically draws a distinction between the different security features of "user authentication" functions and encryption of transaction information (*see, e.g.,* Schrader, Col. 17, ll. 12 – 15).

The Office Action concedes that Schrader does not disclose retrieving encrypted information from the computer-readable storage medium (*id.*, p. 6), and cites Dolphin for this disclosure (*id.*, p. 2). Dolphin is directed to controlling access to publications of periodicals — multiple periodicals are encrypted onto a CD ROM and a customer is given access only to those he has paid for by providing the corresponding access codes (Dolphin, Col. 2, ll. 34 – 44). Dolphin never discloses doing anything with encrypted information other than decrypting it for the user to read. It certainly does not disclose using it to determine access to a customer's financial account as the independent claims require.

Thus, in part, a *prima facie* case of obviousness has not been established since no motivation to combine the references has been shown. The Office Action seems

to suggest that the level of skill in the art is relied upon for such a motivation (Second Office Action, p. 3), but such a basis is improper (*see* MPEP 2143.01, "The level of skill in the art cannot be relied upon to provide the suggestion to combine references").

A *prima facie* case of obviousness has also not been established because none of the prior art cited discloses the claim limitation of decrypting retrieved encrypted information such that a financial institution determines an access to a customer's financial account (*see* MPEP 2143.03). Since such a limitation is included in all of the independent claims, all of the pending claims are patentable over the cited art. While it is believed that combining Schrader and Dolphin is improper, the omission of this element is especially highlighted by assuming *arguendo* that they may be combined. In particular, Schrader teaches providing unencrypted online banking software on a CD ROM and Dolphin teaches providing multiple encrypted products on a CD ROM to restrict access to particular ones. At best, the combination of Schrader and Dolphin would therefore teach providing multiple encrypted software products on a CD ROM, one of which is online banking software, and providing access keys to particular software products based on which ones a purchaser has paid for. Nothing in Schrader, Dolphin, or their combination teaches or suggests using information encrypted on the CD ROM in the manner required by the claims.

Since all of the independent claims are patentable over the cited art, all of the claims that depend from them are also patentable over the cited art.

The above remarks are substantially the same as remarks that were refused entry pursuant to an Advisory Action mailed August 1, 2002 (paper no. 17). The Advisory Action indicated that the remarks did not place the application in condition for allowance because "it would have been obvious to one of ordinary skill to allow a user to decrypt encrypted information *that is intended for said user*" (emphasis added). While such a feature may be similar to what is disclosed in Dolphin, in that the encrypted


periodical information is intended for the customer of the periodicals, the statement does not accurately reflect the claim limitations. In independent Claim 1, for example, a distinction is drawn between a customer and a financial institution. It is the customer who "us[es] said network access device ... to access a customer's financial account," but it is the financial institution that "determines an access to said customer's financial account on the basis of the decrypted information." A similar distinction is also made between the customer and the financial institution in independent Claim 17.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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